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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,719	03/26/2001	Sri K. Canakapalli	ITL.0558US (P11216)	9468
21906	7590	12/27/2007	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			KUMAR, SRILAKSHMI K	
			ART UNIT	PAPER NUMBER
			2629	
			MAIL DATE	DELIVERY MODE
			12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/817,719	<b>Applicant(s)</b> CANAKAPALLI, SRI K.	
	<b>Examiner</b> Srilakshmi K. Kumar	<b>Art Unit</b> 2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The following office action is in response to the Request for Continued Examination filed on September 20, 2007. This Request for Continued Examination has been filed in response to the Board of Patent Appeals and Interferences decision mailed on July 19, 2007.

Claims 7-10 are pending in the application, with only independent claim 7 amended.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 20, 2007 has been entered.

#### ***Claim Rejections - 35 USC § 102***

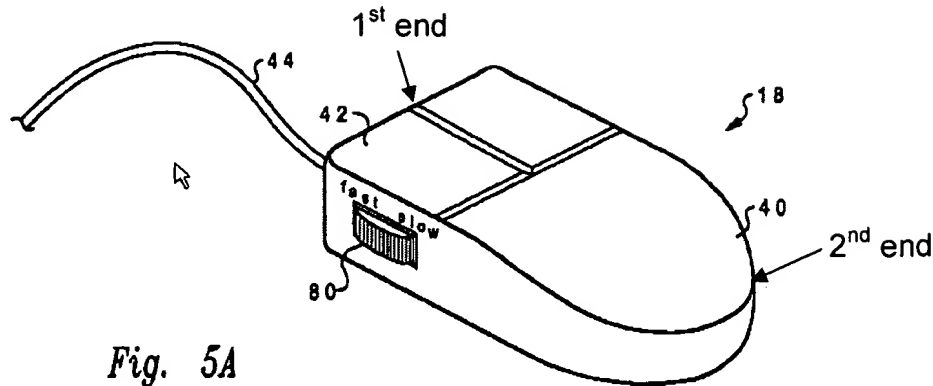
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 7-10 rejected under 35 U.S.C. 102(e) as being anticipated by Jaaskelainen, Jr. (US 6,115,029).

As to independent claim 7, Jaaskelainen, Jr. teaches a mouse (Fig. 5A, item 18) comprising: a body (item 40) including an element (Fig. 5B, item 48) to detect movement of the body (col. 4, lines 23-26, describing Fig. 3B where Jaaskelainen, Jr. teach that is the same as Fig. 5B, col. 5, lines 21-26), said body having an upper surface (Fig. 5A, the top of the mouse), bottom surface (Fig. 5B teaches the bottom surface of the mouse), and a side edge (Fig. 5A, the side edge shown by the side where the dial wheel 80 is located) between said upper surface and said bottom surface (Fig. 5A, the side where the dial wheel 80 is located), said element (48) on said bottom surface (Fig. 5B); a pair of buttons (Fig. 5a, items 42) on said upper surface, said upper surface having a pair of opposed ends (Fig. 5A, as replicated below, and showing a 1st end and a 2nd end as labeled), said buttons closer to one of said ends than to the other of said ends (shown by Fig. 5A as replicated below, where the buttons are against the 1<sup>st</sup> end, thus teaching closer to the 1st end as opposed to 2nd end); and a control (dial wheel, item 80) to enable the user to manually change the rate at which a cursor image moves in response to movement of said body (col. 5, lines 17-26), said control positioned on said edge (80 positioned on the side edge), further from said one of said ends than said buttons (the buttons (42) are positioned against the 1st end, the control (80) is positioned further away from the 1st end than the buttons, thus teaching the limitations).



As to dependent claim 8, limitations of claim 7, and further comprising, Jaaskelainen, Jr. teach wherein said body includes a curved upper surface and a side wall (Fig. 5A shows where the top surface is curved at the 2<sup>nd</sup> end, also the side wall where item 80 is located is also curved towards the 2<sup>nd</sup> end), said control being positioned in said side wall (Fig. 5A, item 80 positioned on the side wall).

As to dependent claim 9, limitations of claim 7, and further comprising, Jaaskelainen, Jr. teach wherein said control is a roller switch (Fig. 5A, item 80, col. 5, lines 17-26, roller switch for controlling the speed of movement).

As to dependent claim 10, limitations of claim 7, and further comprising, Jaaskelainen, Jr. teach wherein said control enables the rate at which the cursor image moves to be manually increased or decreased (Fig. 5A, item 80 is the control switch, and col. 5, lines 17-26 where the movement is manually controlled and increased or decreased).

#### ***Response to Arguments***

4. Applicant's arguments filed September 20, 2007 have been fully considered but they are not persuasive.

Applicant remarks where the amended claims require that the control to enable the user to manually change the rate of cursor movement be spaced farther away from the edge of the top surface of a body than the two buttons. This positions the operator in a normal position for most people, assuming that most people have thumbs shorter than their index fingers.

The prior art of Jaaskelainen, Jr. teach in Fig. 5A a control (80) to enable the user to manually change the rate of cursor movement (col. 5, lines 17-26) be spaced farther away from the edge of the top surface of a body than the two buttons (Fig. 5A, where the buttons are on the top surface, and the control (80) is in the middle of the side wall away from the top surface).

The claimed invention is clearly taught by the prior art of Jaaskelainen, Jr. as shown by the rejection above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srilakshmi K. Kumar whose telephone number is 571 272 7769. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Lefkowitz can be reached on 571 272 3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'S. Kumar', with a stylized, cursive script.

Srilakshmi K Kumar  
Examiner  
Art Unit 2629

SKK  
December 12, 2007